

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Blaine R. Southam

Serial No.: 10/617,002

Filed: July 9, 2003

Group Art Unit: 2143-2443

Examiner: Jean Gilles, Jude

Docket No. 200209006-1

For: **Systems And Methods For Collecting Data Regarding Network Service Operation**

REPLY BRIEF RESPONSIVE TO EXAMINER'S ANSWER

Mail Stop: Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

The Examiner's Answer mailed November 18, 2008 has been carefully considered.

In response thereto, please consider the following remarks.

AUTHORIZATION TO DEBIT ACCOUNT

It is not believed that extensions of time or fees for net addition of claims are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to deposit account no. 08-2025.

Reply Brief Noted By Examiner. A Supplemental Examiner's Answered is attached, correcting the headings of the Previous Examiner's Answer dated 12/18/2008, as per the "Review form/checklist for Appeal Brief or Examiner's Answer" request for correction of 01/30/2009.

/Judge Jean-Gilles/
Primary Examiner
Art Unit 2443

Date: 03/02/2009

REMARKS

The Examiner has provided in the Examiner's Answer various responses to points made in Applicant's Appeal Brief. Applicant addresses those responses in the following.

1. A Client Sending a Message Using a Web Protocol

As noted in Applicant's Appeal Brief, Yairi does not actually disclose or suggest a client "sending a message using a web protocol to a web service on the Internet". Although Yairi discloses a mobile terminal sending a message over a voice network 131, that the message is not sent using a web protocol is clear from the fact that the message is sent to the web service proxy 103, *whose responsibility is to translate the message into a web format. See Yairi, paragraph 0026.*

On pages 13 and 14 of the Examiner's Answer, the Examiner argues that Yairi's mobile terminal does in fact send messages using a web protocol. In supporting that position, the Examiner relies not upon disclosures contained in the Yairi reference but instead upon speculation based upon what the Examiner believes to be what is known by an "average skill in the art." *Examiner's Answer*, page 14. First, the Examiner notes that "IP" is a protocol used for communicating data across a packet-switched internetwork. While this may be true, what the Examiner either fails to mention or fails to grasp is that Yairi does not indicate anywhere in his disclosure that Yairi's mobile terminal communicates using IP. Indeed, Yairi does not even mention the terms "internet protocol" or "IP" anywhere in this disclosure. Therefore, the Examiner's comments regarding IP are irrelevant.

Second, the Examiner appears to argue that Yairi's mobile terminal sends messages using a web protocol because the message is routed to an IM gateway 101, which comprises the web services proxy module 103. In reply, Applicant reiterates that the purpose of web service proxy module 103 is to translate messages received from the mobile terminal into a web protocol and, therefore, messages from the mobile terminal clearly are not sent using a web protocol. As expressed by Yairi:

Generally, web service proxy 103 is responsible for translating messages between IM format and each web service's format.

Yairi, paragraph 0026. In light of that statement, the Examiner's suggestion on page 14 of the Examiner's Answer that the web proxy 103 is not needed for translation lacks merit. Nowhere does Yairi state that the web service proxy 103 is not needed for translating messages into a web service format. Again, the Examiner is relying on speculation instead of the teachings of the references.

Regarding the Examiner's comments on page 14 of the Examiner's Answer about paragraph 0008 and Yairi's discussion of a "generic mechanism," nothing in that paragraph and nothing about Yairi's discussion of the generic mechanism indicates or even suggests that Yairi's mobile terminal sends messages using a web protocol or that the web service proxy 103 is not necessary to translate messages from the mobile terminal into a web protocol. Once again, the Examiner is presenting arguments that are not supported by the reference.

On pages 14 and 15, the Examiner references paragraph 0024 and suggests that Yairi states the following: ". . . when an instant message is directed to a web server,

as described herein, the instant message is routed through the mobile IM server 111 to an Instant Messaging Web Services (IM/WS) Gateway 101 for further processing (because of the availability of a plurality of providers to choose from, thereby avoiding overhead) and delivery to a web server provider, such as web service provider 121, 123, or 125." In reply, Applicant notes that the parenthetical in that quotation was added by the Examiner and does not actually appear in that portion of Yairi's disclosure. In view of that fact it now appears that the Examiner is not only speculating as to what Yairi's system does instead of relying on Yairi's actual teachings, but also misrepresenting those teachings in an attempt to bolster an argument. Although it is true that Yairi mentions overhead elsewhere in his disclosure, Yairi does not in fact state cite the overhead issue as the reason for the "processing" mentioned in the excerpt as proffered by the Examiner. Again, Yairi's explicit disclosure is that the gateway 101 and its web service proxy 103 is used to translate messages from a mobile terminal into a web protocol for a web service. Applicant objects to the Examiner's mischaracterization of the Yairi disclosure as clearly improper and unfair.

On page 15 of the Examiner's Answer, the Examiner identified paragraph 0025 of the Yairi reference. Ostensibly, the Examiner believes that the disclosure of a mobile terminal "accessing web services" establishes that those mobile terminals send messages using a web protocol. In reply, Applicant reiterates again that the mobile terminals "access" web service *via the server 111 and its web service proxy 103*, which is relied upon for translation into a web protocol. Therefore, while the mobile terminals may be said to "access" web services by way of the proxy 103 and its translation

services, there is simply no support for the argument that the terminals send messages using a web protocol.

2. Storing Profiling Information About a Message

As expressed in Applicant's Appeal Brief, Yairi does not in fact disclose or suggest "the network proxy storing profiling information about the message in a database that is separate from the web service". Yairi's web service proxy 103 is not described anywhere in the Yairi reference as storing "profiling information" about a message sent by a client. Instead, Yairi's web service proxy 103 merely *translates* messages from mobile phones for web services 121, 123, and 125.

On page 16 of the Examiner's Answer, the Examiner quotes paragraph 0027 of the Yairi reference in support of the position that Yairi teaches a network proxy storing profiling information about the message in a database. When one reads that paragraph (which was quoted in the Appeal Brief), however, it is clear that Yairi says nothing about profiling. In general, Yairi states that the database stores various web service data. That the information may also comprise "payment information" does *not* mean that "profiling information" is stored. Simply stated, payment information is not profiling information. Moreover, the Examiner's explanation of what the payment information is and how it constitutes profiling information has no basis in the Yairi disclosure. Once again, the Examiner is presenting arguments based solely on speculation.

On pages 16 and 17 of the Examiner's Answer the Examiner further references paragraphs 0028 and 0029, and the web service broker 105. It appears that the Examiner believes that because an IM client can perform a search using specific criteria

that Yairi somehow discloses storing profiling information about a message in a database. Clearly, this is not so. Moreover, Yairi does not in fact describe storing search queries as appears to be suggested by the Examiner at the top of page 17.

3. Storing the Time the Message was Received

As was also noted in Applicant's Appeal Brief, Boucher does not actually disclose or suggest "including the time the message was received by the network proxy". Although Boucher identifies a store and forward proxy 12, nowhere does Boucher indicate that the proxy stores "profiling information" about a received message or that the stored profiling information includes "the time the message was received".

On page 17 of the Examiner's Answer, the Examiner now suggests, for the first time during the prosecution of the instant application, that Boucher "inherently" stores the time a message is received because Boucher purges messages after an expiry time elapses. The problem with the Examiner's analysis, however, is that Boucher does not indicate how the "request expiry time" is calculated. While the Examiner presumes that the expiry time is calculated based on a stored received time, there is no reason that it must be so. For example, the expiry time may be calculated from some time after the message is received, such as the time after some initial processing has been performed. Regardless, just because it *may have been possible* to calculate the expiry time from a stored received time does *not* mean that such functionality is inherent. As described by the Federal Circuit:

Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish inherency. See *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1269, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991).

Scaltech Inc. v. Retec/Tetra, L.L.C., 178 F.3d 1378, 51 USPQ2d 1055 (Fed. Cir. 1999), Revising, 156 F.3d 1193, 48 USPQ2d 1037 (Fed. Cir. 1998). Furthermore, the Federal Circuit has noted:

Under the principles of inherency, if the prior art *necessarily functions* in accordance with, or includes, the claimed limitations, it anticipates.

Atlas Powder Co. v. Ireco Inc., 190 F.3d 1342, 51 USPQ2d 1943 (Fed. Cir. 1999) (emphasis added). Moreover, the Federal Circuit has stated:

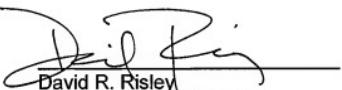
[A] prior art reference may anticipate without disclosing a feature of the claimed invention if that characteristic is *necessarily present*, or inherent, in the single anticipating reference.

Schering Corp. v. Geneva Pharm., Inc., 339 F.3d 1373, 1377 (Fed. Cir. 2003) (emphasis added). Clearly, storage of a received time is not "necessarily present" in Boucher's system to calculate a request expiry time. As such, the Examiner's inherency argument is flawed.

CONCLUSION

In summary, it is Applicant's position that Applicant's claims are patentable over the applied prior art references and that the rejection of these claims should be withdrawn. Appellant therefore respectfully requests that the Board of Appeals overturn the Examiner's rejection and allow Applicant's pending claims.

Respectfully submitted,



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